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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/954,766  
Filing Date: September 18, 2001  
Appellant(s): MANCUSO ET AL.

**MAILED**

**JUN 18 2007**

**GROUP 3600**

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C. Paul Maliszewski  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/23/07 appealing from the Office action  
mailed 5/12/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment filed concurrently with this Appeal Brief has been entered, therefore, claims 6-8 have been canceled.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. It should be noted that claims 6-8 have been canceled (see (4) above).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

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**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Welp et al (US-5518199).

Welp et al discloses an apparatus having all the claimed features. Note, in figures 1 and 2, the coil reel hold-down device comprising "snubber arm" 13 having first and second sections (see figure below) at an obtuse angle to one another as claimed. The snubber arm 13 is pivotably mounted at a first end of the first section to a "base plate" 11. The base plate 11 is deemed to be "operatively arranged to be secured to a floor" via member 9 and the frame (see figure below) of the machine. An actuator (see figure below) is mounted to the base plate 11 and arranged to effect a pivoting movement of the snubber arm 13 relative to the base plate 11. The actuator is connected to the first section of the snubber arm 13 between the pivot point of the snubber arm 13 and the second section of the snubber arm 13. The apparatus is "free-standing" since nothing needs to be activated or de-activated to make it stand and, furthermore, all claimed elements are met/anticipated as noted above.

It is deemed inherent that there is ultimately a floor to which the apparatus is secured because (1) since the snubber arm 13 is used to apply a force against the roll 3, the apparatus including the base plate supporting the snubber arm has to be

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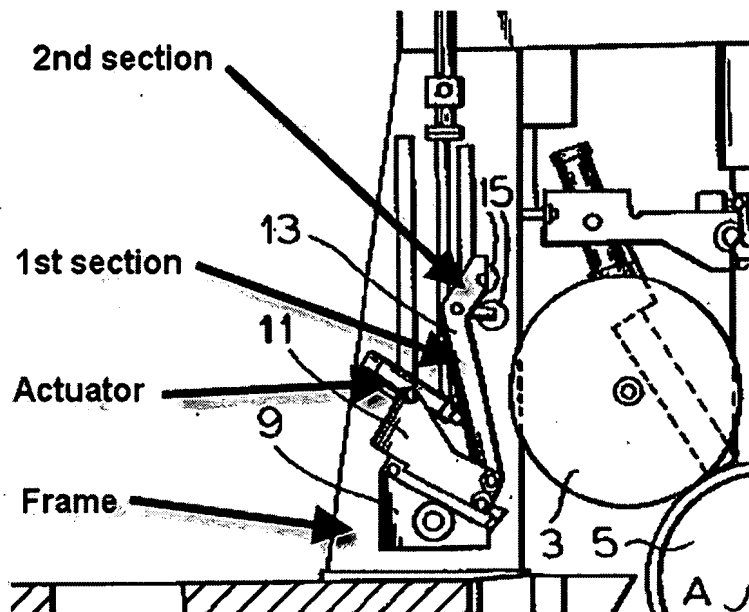
ultimately secured to a floor (just like in appellant's invention), otherwise the snubber arm would not be able to apply a force against the roll 3, it would just tilt instead, (2) the apparatus is a winding machine, the rotational inertia of the rotating rolls 3 necessitate that the apparatus be secured to a floor, (3) since all elements and structures shown in figure 1 cooperate with each other to perform the winding operation, their locations and positions relative to each other have to be fixed as shown and, therefore, would necessitate that all the elements and structures be ultimately secured to a fixed common reference structure such as a floor, and (4) the apparatus is clearly not floating in mid-air and there is no such suggestion in Welp et al.

It should also be noted that "operatively arranged to be secured to a floor" (claim 1, line 2) is deemed to be an intended use of the base plate. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the base plate is deemed capable of being secured to a floor.

Regarding claims 3-5, a snubber device/wheel/roller 15 mounted to the second section of the snubber arm 13 is used to press down on the roll 3.

Regarding claims 9 and 11, the angle between the first and second sections of snubber arm 13 appears to be about 120 degrees.

Regarding claim 10, the length of the first section of the snubber arm 13 appears to be about three times that of the second section.



Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Welp et al (US-5518199).

The particular angular range of movement of the snubber arm 13 of Welp et al. would have been an obvious design consideration to one of ordinary skill in the art depending on factors such as the amount of pivoting needed to bring the snubber device 15 into contact with the roll 3 and then away from and out of the way of the roll 3 when not needed.

#### **(10) Response to Argument**

At the outset, it should be noted that "operatively arranged to be secured to a floor" (claim 1, line 2) is deemed to be an intended use of the base plate. A recitation of

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the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the base plate is deemed capable of being secured to a floor.

Furthermore, the limitation "operatively arranged to be secured to a floor" (claim 1, line 2) is open-ended in that it can include an infinite number of elements in making the base plate capable of being secured to a floor, contrary to appellant's arguments. In other words, the limitation does not preclude the presence of other elements in between the base plate and the floor.

As noted in the rejection above, it is deemed inherent that there is ultimately a floor to which the apparatus is secured because (1) since the snubber arm 13 is used to apply a force against the roll 3, the apparatus including the base plate supporting the snubber arm has to be ultimately secured to a floor (just like in appellant's invention), otherwise the snubber arm would not be able to apply a force against the roll 3, it would just tilt instead, (2) the apparatus is a winding machine, the rotational inertia of the rotating rolls 3 necessitate that the apparatus be secured to a floor, (3) since all elements and structures shown in figure 1 cooperate with each other to perform the winding operation, their locations and positions relative to each other have to be fixed as shown and, therefore, would necessitate that all the elements and structures be ultimately secured to a fixed common reference structure such as a floor, and (4) the apparatus is clearly not floating in mid-air and there is no such suggestion in Welp et al.

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It should be noted that the frame (see figure above) also sits on structures to the right of the cross-hatched element of Welp et al. Furthermore, since the frame is not shown cross-hatched, it is therefore not in the same vertical plane as the cross-hatched element and it may or may not sit on the cross-hatched element at all.

Since no separate arguments have been presented for claim 12, claim 12 stands or falls with claim 1.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/John Q. Nguyen/

John Q. Nguyen  
Primary Examiner  
Art Unit 3654

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